

Remarks

I. Status of the Application and Claims

As originally filed, the present application had a total of 24 claims. These were cancelled and new claims 25-100 were introduced in a Preliminary Amendment filed by Applicants on August 5, 2004. In the present response, Applicants have added new claim 101. Thus, after the entry of the present amendments, the pending claims will be 25-101.

II. The Amendments

All of the amendments made herein, with the exception of the amendments to claim 100 and the introduction of new claim 101, were designed to eliminate cross reference between claims that the Examiner found to be confusing. All variables are still defined as the result of the dependent claims incorporating all limitations of their base claims. Thus, Applicants do not believe that the claims have been changed substantively, but language that may have been confusing has been eliminated.

Claim 100 was amended so that it now refers solely to a process for making compounds defined by claim 25. New claim 101 is directed solely to a method of producing the compounds of claim 63. These amendments were made in accordance with suggestions of the Examiner appearing in the Office Action on page 4 and relating to rejections made under 35 U.S.C. § 112, second paragraph.

None of the amendments made herein adds new matter to the application, and their entry is therefore respectfully requested.

III. Confirmation of Restriction Group Election

Applicants hereby confirm that they have elected restriction Group I, which includes claims 25-60, 63-97 and 100. It is respectfully requested that the claims in the non-elected restriction groups, *i.e.*, claims 61, 62, 98 and 99, be cancelled without prejudice.

IV. Request for Acknowledgement of Cited Art

Applicants wish to thank the Examiner for acknowledging the references cited in most of the Information Disclosure Statements filed. However, there was one Supplemental Information Disclosure Statement (filed on August 19, 2003) that was not included in the papers returned. A copy of the papers as filed, including a date-stamped postcard indicating receipt of the documents by the Patent and Trademark Office is enclosed herewith. It appears that the Examiner must have received this Information Disclosure Statement and considered it since the Office Action refers to U.S. patent 6,436,959 (the sole patent cited in the Supplemental IDS) in item 6 and seems to indicate that it was cited on a 1449 form. Nevertheless, Applicants respectfully request the receipt of an initialed 1449 form indicating that the reference has been considered.

V. Submission of Terminal Disclaimer

Applicants are submitting herewith a Terminal Disclaimer which disclaims the terminal portion of the term of any patent issuing on the present application that would extend beyond U.S. patent 6,153,626. This Terminal Disclaimer is being submitted to overcome the Double Patenting rejection appearing on pages 4 and 5 of the Office Action.

The Rejections

I. Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph

On pages 3 and 4 of the Office Action, the Examiner rejects claims 28, 36, 44, 47, 52, 65, 66, 74, 79, 82, 85, 90 and 100 under 35 U.S.C. § 112, second paragraph. For all of these claims, except for claim 100, the rejection is based upon the allegation that a dependent claim is confusing because it refers back to a previous claim other than the immediate base claim. In each case, Applicants have amended claims to delete the language that the Examiner found to be objectionable. The amendments were made in direct compliance with suggestions that appear in the Office Action on pages 3 and 4 and Applicants believe that they should be sufficient to overcome the rejections that have been made.

With respect to claim 100, the Examiner found steps (b) and (d) to be open-ended, embracing modifications to R¹ that go beyond the application. In response, Applicants have deleted both of these steps from claim 100. In addition, Applicants have followed the Examiner's recommendation to make claim 100 solely dependent upon claim 25 and to refer solely to claim 25 in defining variables. New claim 101 was introduced which refers solely to claim 63. Applicants submit that these amendments should be sufficient to overcome the Examiner's rejection.

II. Rejection of Claims on Double Patenting Grounds

On pages 4 and 5 of the Office Action, the Examiner rejects claims 25-60, 63-97 and 100 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20, 24, 27 and 28 of U.S. patent 6,153,626.

In response, Applicants are submitting herewith a Terminal Disclaimer disclaiming the terminal part of any term for a patent issuing on the present application that would extend beyond the term of U.S. 6,153,626. Applicants therefore respectfully submit that the rejection of claims on double patenting grounds has been overcome.

Conclusion

In view of the amendments and remarks above, Applicants respectfully submit that all of the Examiner's rejections have been overcome. It is therefore requested that these rejections be withdrawn and that the claims presently pending in the application be allowed.

If, in the opinion of the Examiner, a phone call may help to expedite the prosecution of this application, the Examiner is invited to call Applicants' undersigned attorney at (202) 419-7013.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By: Michael A. Sanzo

Michael A. Sanzo
Attorney for Applicants
Reg. No. 36,912

Date: December 15, 2004
1801 K Street, N.W., Suite 401L
Washington, D.C. 20006
(202) 419-7013

Attachments: Information Disclosure Statement
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and date-stamped postcard